



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/783,894

02/20/2004

Joseph J. Kubler

14364US18

7624

23446 7590 05/11/2010
MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

CAMPBELL, MATTHEW T

ART UNIT

PAPER NUMBER

2465

MAIL DATE

DELIVERY MODE

05/11/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/783,894	Applicant(s) KUBLER ET AL.	
	Examiner MATTHEW CAMPBELL	Art Unit 2465	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Applicant's arguments have been considered but they are not persuasive.

Applicant argues that Suffern does not teach providing a host device with information requesting call setup and receiving from the host device configuration information based on the request (**Remarks, p. 18**). Applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The previous office action establishes that Israel teaches receiving information requesting setup of a call and establishing the call based on the information, and applicant does not disagree. Israel does not teach a host device; however, Suffern from the same field of endeavor teaches implementing a network controller as an expansion card that utilizes a microprocessor and memory of a host device, thus reducing the cost of the interface card and facilitating revision without requiring hardware modification (**fig. 1, col. 1 line 58 - col. 2 line 45**). Similarly, applicant's specification teaches implementing the interface circuitry as an expansion card in order to access a host device's processing unit and storage devices (**fig. 56a, pp. 271-272**). It would have been obvious to modify Israel with Suffern in order to reduce cost and facilitate revision as taught by Suffern.

Applicant further argues that Suffern does not teach two interfaces (**Remarks, pp. 18-19**); however, applicant's argument is unpersuasive, because Israel is cited as teaching the two interfaces for coupling packet and circuit networks (**fig. 1 and col. 3**).

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 44, 48-50, 53-56, 61, 63, 64, 67, 68, 71, 75-77, 80-83 and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al. (US 4723238 A) in view of Suffern et al. (US 5724413 A).

For claim 44 and 71, Israel teaches a method for communicatively coupling a packet network to at least one communication network having an associated information format, the method comprising: receiving, from one of the packet network and the at least one communication network, information requesting setup of a call between the packet network and the at least one communication network **(Israel: network interface card 14 receives call originating from packet terminal 131-X or circuit terminal 121-X, fig. 1 and col. 3)**; and establishing call communication between the packet network and the at least one communication network based upon the information, the communication including the conversion of information received in a packet format for transmission in the associated format, and the conversion of information received in the associated format for transmission in a packet format **(Israel: network interface controller 14 establishes communication path between packet terminal 131-X and circuit terminal 121-X using data converter 145X, fig. 1 and col. 3)**.

Israel does not teach providing, to a host device, at least a portion of the information requesting setup of a call; receiving, from the host device, configuration

Art Unit: 2465

information based upon the at least a portion of the information requesting setup of a call. However, Suffern from a similar field of endeavor teaches an interface card that provides received signals to the host device for processing (**Suffern: figs. 1-4**). It would have been obvious to modify Israel incorporate Suffern's teaching in order to reduce the cost of the interface card and to facilitate revision without requiring hardware modification.

For claim 48 and 75, Israel teaches the method of claim 44 and 71 wherein packets comprise non-voice data (**Israel: Inter-system data calls, col. 9**).

For claim 49 and 76, Israel teaches the method of claim 48 and 75 wherein at least a portion of the non-voice data is unrelated to the communication of digitized voice information (**Israel: Inter-system data calls, col. 9**).

For claim 50 and 77, Israel teaches the method of claim 44 and 71 wherein the at least one communication network is a second packet network (**Israel: may establish calls between PSS terminals, col. 2 line 55**).

For claim 53 and 80, Israel in view of Suffern teaches the method of claim 44 and 71 wherein the at least one communication network comprises a conventional telephone switching network (**Israel: CSS supports voice calls, col. 2 line 44; Suffern: telephone network 30, fig. 1**).

For claim 54 and 81, Israel in view of Suffern teaches the method of claim 53 and 80 wherein the associated format is an analog format **(Suffern: telephone network 30 and analog converter 40, fig. 2).**

For claim 55 and 82, Israel teaches the method of claim 53 and 80 wherein the associated information format is a digital format **(Israel: CSS utilizes PCM voice samples or digital data, col. 4 line 49).**

For claim 56 and 83, Israel in view of Suffern teaches the method of claim 53 and 80 wherein the associated format is a modem signal **(Suffern: modem signal, col. 4 line 10).**

For claim 61 and 88, Israel in view of Suffern teaches the method of claim 44 and 71 wherein the host device is a personal computer **(Suffern: conventional IBM computer 20, fig. 1).**

For claim 63, Israel teaches a machine-readable storage having stored thereon a computer program having a plurality of code sections for implementing a system supporting communication between a packet network and at least one other network, the at least one other network having an associated communication format, the code section executable by a machine for causing the machine to perform operations

Art Unit: 2465

comprising: accepting a request for setup of a call, the request identifying the at least one other network **(Israel: packet switching system 13 or circuit switching system 12 receives call originating from packet terminal 131-X or circuit terminal 121-X, fig. 1 and col. 3)**; providing, to a host device, information related to the call setup request; receiving, from the host device, call parameters derived from the information related to the call setup request **(Israel: packet switching system 13 or circuit switching system 12 forwards request to network interface terminal 14, fig. 1 and col. 3)**; and communicatively coupling the packet network and the at least one other network, based upon the call parameters **(Israel: network interface controller 14 establishes communication path between packet terminal 131-X and circuit terminal 121-X using data converter 145X, fig. 1 and col. 3)**.

For claim 64, Israel teaches the machine-readable storage of claim 63 wherein the coupling comprises: converting information from a packet format to the associated communication format of the at least one other network; and transforming information from the associated communication format of the at least one other network to a packet format **(Israel: data converters 145X convert between packet and circuit formats, col. 6 line 23)**.

For claim 67, Israel in view of Suffern teaches the machine-readable storage of claim 63 wherein the at least one other network comprises a conventional telephone

Art Unit: 2465

switching network (**Israel: CSS supports voice calls, col. 2 line 44; Suffern: telephone network 30, fig. 1).**

For claim 68, Israel in view of Suffern teaches the machine-readable storage of claim 67 wherein the associated communication format of the at least one other network is an analog format (**Suffern: telephone network 30 and analog converter 40, fig. 2).**

3. Claims 45, 46, 51, 52, 65, 66, 72, 73, 78 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al. (US 4723238 A) in view of Suffern et al. (US 5724413 A) and Row et al. (US 5163131 A).

For claim 45 and 72, Israel in view of Suffern does not teach the method of claim 44 and 71 wherein the packet network is compliant with an Internet protocol (IP). However, Row teaches a packet network that is compliant with IP (**Row: TCP/IP, cols. 5 and 6**). It would have been obvious to one having ordinary skill in the art to modify Israel and Suffern with Row's teaching in order to interface with other IP networks.

For claim 46 and 73, Israel in view of Suffer and Row teaches the method of claim 45 and 72 wherein the Internet Protocol is compliant with the transmission control protocol (TCP)/Internet protocol (IP) (**Row: TCP/IP, cols. 5 and 6**).

For claim 51 and 78, Israel in view of Suffern does not teach the method of claim 50 and 77 wherein the second packet network is compliant with an Internet protocol (IP). However, Row teaches a packet network that is compliant with IP (**Row: TCP/IP, cols. 5 and 6**). It would have been obvious to one having ordinary skill in the art to modify Israel and Suffern with Row's teaching in order to interface with other IP systems.

For claim 52 and 79, Israel in view of Suffer and Row teaches the method of claim 51 and 78 wherein the Internet Protocol is compliant with the transmission control protocol (TCP)/Internet protocol (IP) (**Row: TCP/IP, cols. 5 and 6**).

Art Unit: 2465

For claim 65, Israel in view of Suffern does not teach the machine-readable storage of claim 63 wherein the packet format is compliant with an Internet protocol (IP). However, Row teaches a packet network that is compliant with IP (**Row: TCP/IP, cols. 5 and 6**). It would have been obvious to one having ordinary skill in the art to modify Israel and Suffern with Row's teaching in order to interface with other IP networks.

For claim 66, Israel in view of Suffer and Row teaches the machine-readable storage of claim 65 wherein the packet format is the transmission control protocol (TCP)/Internet protocol (IP) (**Row: TCP/IP, cols. 5 and 6**).

4. Claims 47, 57-60, 69, 74 and 84-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al. (US 4723238 A) in view of Suffern et al. (US 5724413 A) and Flanagan (US 4100377 A).

For claim 47 and 74, Israel in view of Suffern does not teach the method of claim 44 and 71 wherein packets comprise digitized voice information. However, Flanagan teaches packets comprising digitally encoded speech (**Flanagan: packet transmission of speech, figs. 1-4**). It would have been obvious to one having ordinary skill in the art to modify Israel and Suffern with Flanagan's teaching in order to accommodate voice on shared transmission facilities with the packets.

For claim 57 and 84, Israel in view of Suffern does not teach the method of claim 44 and 71 wherein the conversion of information received in a packet format for transmission in the associated format comprises converting digitized voice information into an analog voice signal. However, Flanagan teaches a speech packet regenerator for generating voice signals (**Flanagan: speech regenerator, fig. 3 and col. 5**). It would have been obvious to one having ordinary skill in the art to modify Israel and Suffern with Flanagan's teaching in order to communicate voice between the packet and circuit networks.

For claim 58 and 85, Israel in view of Suffern does not teach the method of claim 44 and 71 wherein the conversion of information received in a packet format for transmission in the associated format comprises buffering digitized voice information for a period of time to minimize gaps in a voice signal. However, Flanagan teaches balancing silent interval lengths, talkspurt delivery times and receive buffer lengths with

Art Unit: 2465

the intelligibility of the delivered speech (**Flanagan: col. 2 lines 10-24**). It would have been obvious to one having ordinary skill in the art to modify Israel and Suffern with Flanagan's teaching in order to balance buffer size with voice quality.

For claim 59 and 86, Israel in view of Suffern does not teach the method of claim 44 and 71 wherein the conversion of information received in the associated format for transmission in the packet format comprises converting an analog voice signal into digitized voice information. However, Flanagan teaches a speech packet generator for generating digitally encoded speech packets (**Flanagan: speech generator, fig. 2**). It would have been obvious to one having ordinary skill in the art to modify Israel and Suffern with Flanagan's teaching in order to communicate voice between the packet and circuit networks.

For claim 60 and 87, Israel in view of Suffern does not teach the method of claim 44 and 71 wherein the at least one converter reduces the number of voice packets transmitted via the at least one packet network, by changing the packetization of digitized voice information when voice activity on the at least one network interface is below a predetermined level. However, Flanagan teaches that speech signals are encoded in talkspurts such that silent intervals are deleted (**Flanagan: col. 2 line 1**). It would have been obvious to one having ordinary skill in the art to modify Israel and Suffern with Flanagan's teaching in order to preserve bandwidth.

For claim 69, Israel in view of Suffern does not teach the machine-readable storage of claim 63 further comprising: communicating with the host device digitized voice information. However, Flanagan teaches packets comprising digitally encoded speech (**Flanagan: packet transmission of speech, figs. 1-4**). It would have been obvious to one having ordinary skill in the art to modify Israel and Suffern with Flanagan's teaching in order to accommodate voice on shared transmission facilities with the packets.

5. Claims 62, 70 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al. (US 4723238 A) in view of Suffern et al. (US 5724413 A) and Messenger (US 5046066 A).

For claim 62 and 89, Israel in view of Suffern does not teach the method of claim 44 and 71 wherein the packet network is a wireless network. However, Messenger teaches a wireless packet network (**Messenger: figs. 1-2**). It would have been obvious to one having ordinary skill in the art to modify Israel in view of Suffern with Messenger's teaching in order to provide mobile data nodes.

For claim 70, Israel in view of Suffern does not teach the machine-readable storage of claim 63 wherein the packet network is a wireless network. However, Messenger teaches a wireless packet network (**Messenger: figs. 1-2**). It would have

been obvious to one having ordinary skill in the art to modify Israel in view of Suffern with Messenger's teaching in order to provide mobile data nodes.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW CAMPBELL whose telephone number is 571-270-3988. The examiner can normally be reached on Monday through Friday from 9:00am until 6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Patel can be reached on 571-272-2988. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2465

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. C./
Examiner, Art Unit 2465
5-2-2010

/Jayanti K. Patel/
Supervisory Patent Examiner, Art Unit 2465